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EXAMINER

WELLS, LAUREN Q

ART UNIT PAPER NUMBER

1617

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/640,822
Filing Date: August 17, 2000
Appellant(s): GERS-BARIAG ET AL.

Howard Lee
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/26/04.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 16-28 and 31 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(9) Prior Art of Record

6,153,204	Fanger et al.	11/28/2000
5,939,054	Msika et al.	8/17/1999

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fanger et al. (6,153,204) in view of Msika et al. (5,939,054).

The instant invention is directed toward a cosmetic or dermatological stick preparation, which is a water-in-oil emulsion, comprising an oil phase which comprises 10-70% of fatty and/or wax components which melt above a temperature of 40 C, a water phase, at least one modified phyllosilicate pigment particles which exhibits both hydrophilic and lipophilic properties, at most 0.5% of one or more emulsifiers.

Fanger et al. teach cosmetic or pharmaceutical preparations with a reduced feeling of stickiness. The preparations are taught as emulsifier-free, water-in-oil lipodispersions. Lipsticks and deodorant sticks are taught as forms of the preparations, wherein the preparations are applied to the skin. Aluminum silicates, such as bentonites are taught as thickeners for use in the preparations. Paraffin oils, castor oil, isopropyl myristate, vaseline, lanolin, beeswax, ceresin,

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ozokerite, carnauba wax, candelilla wax and others are taught as preferred oily substances (fatty and/or wax components which melt above 40 C). UVA and UVB filters, iron oxides, zinc oxides, antioxidants, dyes, coloring pigments and bactericides are taught as additional additives for use in the preparations (additives/active ingredients, amphiphilic metal oxides). Water-in-oil emulsions are preferred forms of the composition. The reference lacks preferred modified hectorites and methods of preparing the emulsions. See Col. 2, lines 6-34; Col. 3, lines 9-61; Col. 6, lines 54-62; Col. 8, lines 1-19; Col. 9, line 16-Col. 10, line 29.

Msika et al. teach water-in-oil sunscreen emulsions in the form of sticks. Quaternium 14 and 18 hectorite are taught as gelling derivatives for use in the emulsions. These compounds are further taught as optimizing the stability of water-in-oil emulsions and potentiating the solar protection in the highest protection factors. Taught is a method of making the emulsion, wherein the aqueous phase is added to the fatty phase with slow stirring.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to exemplify the instant water-in-oil emulsions using the teachings of Fanger et al. because Fanger et al. teach emulsifier-free, water-in-oil emulsions comprising oily phase constituents that melt above 40 C and teach aluminum silicate (a phyllosilicate) as a thickener for use in the emulsion, wherein the emulsion can be in the form of a lipstick; hence, using the teachings of Fanger et al. to arrive at the instant invention would be within the skill of one in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the quaternium-18 hectorite of Msika et al. for the aluminum silicate in Fanger et al. because of the expectation of optimizing the stability of water-in-oil emulsions and

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of potentiating the solar protection of the emulsion, and because the replacement of one phyllosilicate gelling agent for the other, for cosmetic thickening purposes, would be within the skill of one in the art.

Regarding the term "lipodispersion" in Fanger et al., it is respectfully pointed out that water-in-oil emulsions are lipodispersions, as the definition of an emulsion, as given by Webster's Collegiate Dictionary, is a liquid dispersed with or without emulsifier in an immiscible liquid.

For the purposes of searching for an applying prior art under 35 USC 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to comprising. If an applicant contends that additional steps or material in the prior art are excluded by the recitation of "consisting essentially of", applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. See MPEP 2111.03.

(11) *Response to Argument*

Appellant argues, "As knowledge of the applicants' disclosure must be put aside in determining whether the appellants' claims are prima facie obvious over the prior art, the appellants' fail to see how one of ordinary skill in the art would arrive at the appellants' claimed invention when considering the references as a whole even before address considerations of desirability to combine or modify the teaching of the references and having a reasonable expectation of success". This argument is not persuasive. It is respectfully pointed out that in response to appellants' argument that the examiner's conclusion of obviousness is based upon

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improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Appellant states/argues, "(As a practical exercise, cover the column containing appellants' claim 16 and ask another Board member who is unfamiliar with the prosecution history to draft a claim which is obvious in light of the Fanger and Msika reference; appellants' believe this claim would bear little resemblance to the appellants' claims). . .(As an illustrative exercise: Cover the column containing the description of Appellants' claim 16 in the chart above and show the remaining columns to a person unfamiliar with the prosecution history of this application. Appellants believe that person would not draft a claim which approximates the appellants' claim 16)". This argument is not persuasive. It is respectfully pointed out that Appellant is arguing against the exemplifications of the references. However, the instant rejection is a 103-obviousness rejection and not a 102-anticipation rejection. As such, it is respectfully pointed out that the Examiner has not relied merely on the teachings of the claims and the exemplifications of the references to arrive at the instant rejection, but has considered the reference as a whole for what it teaches one of ordinary skill in the art. In summary, it is respectfully pointed out that it is well-established that consideration of a reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches, when viewed in light of the admitted knowledge in the art, to person of ordinary skill in the art. *In re Boe*, 355 F.2d 961, 148 USPQ 507, 510 (CCPA 1966); *In re Lamberti*, 545 F.2d 747, 750, 192 USPQ 279, 280

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(CCPA 1976); In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 570 (CCPA 1982); In re Kaslow, 707 F.2d 1366, 1374, 217 USPQ 1089, 1095 (Fed. Cir. 1983).

Appellant argues, “the appellants fail to see how the person of ordinary skill in the art without knowledge of the applicants disclosure would have arrived at the appellants’ invention given that the as a whole teaching of Fanger appears to be directed to reducing stickiness of already known compositions by adding starch n-octenyl succinate and Msika is directed toward a synergistic mixture of titanium and/or zinc oxide particles”. This argument is not persuasive. The Examiner first directs Appellant to Col. 2, lines 32-34, which states, “**W/O lipodispersions, which are the subject matter of the present invention**, are, by reverse analogy, **emulsifier-free finely disperse** preparations of the water-in-oil type”. The Examiner second directs Appellant to Col. 10, line 35-Col. 12, line 30 and Col. 14, line 55-Col. 15, line 10, of Fanger, which exemplify such water-in-oil emulsions containing 10-70% of an oil phase, wherein the oil phase contains fatty and/or wax components which melt above a temperature of 40 C. As an illustration, it is respectfully pointed out Example 14, spanning columns 14 and 15, is a stick (lipstick) in the form of a finely disperse water-in-oil emulsion comprising an oil phase which containing from 10-70% of fatty and/or wax components which melt above 40 C, a water phase, and a thickener. Furthermore, Fanger et al. teach aluminum silicates (phyllosilicate pigment particle), such as bentonites as thickeners for use their compositions. Msika is merely relied upon for their teachings of quaternium 14 and 18 hectorite (phyllosilicate pigment particle) as phyllosilicate thickeners that are cosmetically acceptable.

Appellant argues, “The Examiner’s characterization of the Fanger reference has been misleading throughout the prosecution as it indicates a level of similarity with the appellants’ claim invention which simply does not exist. The above chart indicated in bold some of the key

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elements of the appellants' invention which included: (1) stick preparation; (2) water-in-oil emulsion; (3) modified phyllosilicate pigment with amphiphilic character; (4) at most 0.5 by weight of one or more emulsifiers. This is a collective package of elements which must always be simultaneously present in the appellants' invention". This argument is not persuasive. As pointed out above, example 14 of Fanger et al. contains all of these elements except for the pigment and 0.5% or less emulsifier, wherein the teachings in the specification of Fanger et al. and the teachings of Msika et al. are utilized to render the addition of the pigment and emulsifier-free, as obvious. It is not apparent to the Examiner as to how this is misleading, as the instant rejection merely brings this to light.

Appellant argues, "There is no such recognition for this collective package of elements in the Fanger reference. The Examiner must resort to improper picking and choosing in order to collect the elements necessary to approximate the appellants' invention". This argument is not persuasive, as it is incorrect. The Examiner again respectfully directs Appellant to Example 14 of Fanger et al. It is further respectfully pointed out that, as pointed out in the above rejection and arguments, in addition to Example 14 teaching all the limitations of the instant claim except for the pigment and 0.5% or less emulsifier, Fanger et al. teach aluminum silicates as thickeners for use in their compositions, wherein aluminum silicates are phyllosilicates, and teach their preferred embodiments as emulsifier free. Msika et al. teach quaternium 14 and 18 hectorites (phyllosilicates) as thickeners for use in water-in-oil emulsions, wherein these compounds optimize the stability of water-in-oil emulsions and potentiate the solar protection in the highest protection factors. Thus, one of skill in the art would be motivated to add quaternium 18 hectorite to the water-in-oil emulsion of Fanger et al. or substitute quaternium 18 hectorite for

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aluminum silicate, as taught by Fanger, because of the benefits of quaternium 18 hectorite taught by Msika et al.

Appellant argues, “The appellants’ believe that the Fanger reference fails to teach at a minimum the limitation of the amount of emulsifier as represented in appellants’ claims 16 and 17”. This argument is not persuasive. The Examiner does not understand how Appellant believes that Fanger does not teach these limitations. As pointed out on numerous occasions, and again, Col. 2, lines 32-34, of Fanger states, “W/O lipodispersions, which are the subject matter of the present invention, are, by reverse analogy, emulsifier-free finely disperse preparations of the water-in-oil type”.

Appellant argues, “There is no recognition that Fanger’s cosmetic or topical dermatological preparation would simultaneously have the elements of the appellants’ invention. . .At best, Fanger only conceives of having one or two of these elements present in the invention at any given time and there is no teaching, suggestion or motivation from Fanger or Msika which would lead one of ordinary skill in the art to modify the core of Fanger’s invention to incorporate all of the elements as the appellants’ have done”. This argument is not persuasive. For the reasons stated in the above rejection and arguments, the teachings of Fanger render the instant invention obvious.

Appellant argues, “Msika appears to be primarily relied upon for the substitution of quaternium 14 and 18 hectorite for aluminum silicate as the phyllosilicate. However, both examples which use this phyllosilicate are not sticks based on water-in-oil emulsions. . .In addition, this reference also teaches that when their compositions are emulsions of the water-in-oil type. . .the concentration of emulsifying system is between 4 and 35% by weight with respect

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to the total eight of the emulsion”. This argument is not persuasive, as Msika et al. is merely relied upon to teach preferred modified phyllosilicates that are cosmetically acceptable for use in water-in-oil emulsions and for application to the skin of a user. It is respectfully pointed out that the Examiner could have relied upon any other reference that taught quaternium 14 and 18 hectorites as thickening agents for cosmetic water-in-oil emulsions.

Appellant argues, “The closest embodiments to the appellants’ invention are Example 13 and 14 of the Fanger reference. Both of these examples do not have ANY pigment particle much less a modified phyllosilicate pigment particle. . . Example 14, while being a water-in-oil emulsion stick, can only be formulated by using 3.5% of polyglyceryl-3-dioleate, a known emulsifier. Collectively, these Examples would have suggested to one of ordinary skill in the art that use of hydrophilic starch esterified with one or more n-octenylsuccinate radicals in a stick preparation would have required an excess of emulsifier for a water-in-oil emulsion stick or that low emulsifier or emulsifier free sticks could only have been achieved by removing the water phase”. This argument is not persuasive. Again, Appellant is arguing against the examples. It is again respectfully pointed out that the instant rejection is an obviousness rejection, wherein a reference in a obviousness rejection is not limited to the teachings of its claims or preferred embodiments, but is considered as a whole for what it teaches/renders obvious to one of ordinary skill in the art. And, as pointed out previously, Col. 2, lines 32-34, of Fanger, states, “W/O lipodispersions, which are the subject matter of the present invention, are, by reverse analogy, emulsifier-free finely disperse preparations of the water-in-oil type”.

For the above reasons, it is believed that the rejections should be sustained.


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Respectfully submitted,

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June 12, 2004

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